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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,174	12/28/2001	Jitendra Patel	J6742(C)	8957

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PATENT DEPARTMENT
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EXAMINER
ELHILO, EISA B

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 08/14/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/034,174	PATEL ET AL.	
	Examiner	Art Unit	
	Eisa B Elhilo	1751	

-- The MAILING DATE of this communication appears on the cover she t with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 December 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4 & 5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Claims 1-34 are pending in this application.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because of improper format. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

2. Claim 2 objected to because of the following informalities:

Claim 2 objected to because the words in the lines of the claim are crowded too closely together or improperly spaced, making reading and entry of amendments difficult. Appropriate correction is required.

Claim 2, also objected to because the terms "N, N-bis (hydroxyethyl)-2,4-diaminophenol" on page 44, lines 24-25 and "2,4-diamino-5-methylphenol" page 44, lines 28-29 are misspelled. Appropriate correction is required.

Claim 29 objected to because the claim recites the imitation "part ai and part ai " wherein the second "part ai " should be changed to "part aii ". Correction is required to make the claim clear and more definite.

Double Patenting

3 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-34 provisionally rejected under the judicially created doctrine of double patenting over claims 1-9 and 13-40 of co-pending Application No. 10/034511, claims 1-23 of co-pending Application No. 10/096812, claims 1-26 of co-pending Application No. 10/095657 and claims 1-2 and 4-28 of co-pending Application No. 10/196130. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending applications and would be covered by any patent granted on these co-pending applications since the referenced co-pending applications and the instant application are claiming common subject matter, as follows: All claims are drawn to the similar methods for permanently dyeing hair using similar steps for applying similar mixture compositions of oxidative dye intermediates in a shampoo base at alkaline pH and oxidative compound in a shampoo base at

acidic pH and wherein all sets of the claims recite similar conditioning agents presented in the compositions. The claims are differ only in that the instant claims require at least one of part ai or part aii has about 0.01 to about 5.0% of a conditioning agent.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply such a method for dyeing hair by incorporating a dye composition that may comprise conditioning agents because the co-pending applications teach similar methods for dyeing hair wherein the methods comprise the steps of applying to the hair dyeing compositions that comprise conditioning agents such as fatty alcohol (structurant) (co-pending application No. 10/034511), conditioner bases (quaternary ammonium compounds) and fatty alcohols (co-pending application No. 10/196130), conditioning agents (fatty alcohols) (co-pending application No.10/095657) and conditioning agent of gelling agent (fatty alcohol) (co-pending application No. 10/096812) thus, a person of the ordinary skill in the art would be motivated to select and choose fatty alcohols (structurants), conditioner bases (quaternary ammonium compounds) or gelling agents (fatty alcohols) as a conditioning agent as taught by the co-pending applications and would expect such a method to have similar results to those claimed, absent, unexpected results.

Claim Rejections - 35 USC § 103

4 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 7-28 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casperson et al. (US 5,376,146) in view of Lapidus et al. (US 4,104,021).

Casperson (US' 146) teaches a method for dyeing hair. The method comprises the step of contacting the hair with a mixture of a two part aqueous composition of a) an alkaline aqueous lotion having a pH of from about 7 to about 11 which within the claimed range as claimed in claim 3 (see col. 3, 50-52) containing from about 0.005% by weight to about 5% by weight (equimolar quantities of oxidation bases and couplers) of at least one primary intermediate such as para-phenylenediamine, from 0.005% to about 5% by weight of at least one coupler for the formation of oxidation dyes as claimed in claims 1, 2, 5, 27 and 28 (see col. 8, lines 30-34), from about 0.1% to about 5% of a conditioner agent and at least 70% by weight water and may be as higher as 95% or higher to make the lotion (shampoo base) in an aqueous condition which falls within the claimed ranges as claimed in claims 5 and 24 (see col. 3, lines 50-53 and col. 4, lines 3-4), and b) an aqueous developer (oxidizing agent) having a pH of from about 2.5 to 4.5 which is overlapped with the claimed range as claimed in claim 4 and containing from about 0.5% by weight to about 40% of a peroxide oxidizer such as hydrogen peroxide as claimed in claim 23 (col. 3, lines 57-62, col. 9, lines 52-53 and claim 9). At the end of the coloring period the composition is washed from the hair with ordinary water as claimed in claim 31 (see col. 10, lines 64-66 and col. 11, lines 20-24). Casperson also teaches a method for dyeing hair comprising the dyeing composition as described above, wherein the viscosity of the dyeing composition is from 1 cps to about 5000 cps by weight which overlaps with the claimed range as claimed in claim 25 (see col. 10, lines 35-37). Casperson further, teaches a method for dyeing hair comprising applying to the hair the dyeing composition as described above, which may be

separately provided and ready for mixing by the finger manipulation (hand) as claimed in claim 30 to initiate the dyeing process (see col. 10, lines 67-68 and col. 11, lines 1-4 and lines 29-35).

The instant claims differ from the reference by reciting a method for dyeing hair comprising applying to the hair a dyeing composition for a number of treatments having a set time interval of about 8 hours and 30 days between each two consecutive such treatment as claimed. Further, the reference fails to teach the period for contacting hair between ½ minute and two minutes as claimed in claim 7 and the time interval of 1 day and 3 days as claimed in claim 8. Furthermore, the reference does not teach or disclose the physical properties of the hair such as highlighted, combing force, combing index, minimize hair outgrowth, delta E and IR absorption and break stress as claimed in claims 9-22.

Lapidus (US' 021) in analogous art of hair dyeing processes, teaches a process for dyeing hair comprising applying to the hair a mixture of a colorant-oxidative solution in successive applications for a time period up to 5 minutes and of substantially the same length for each subsequent application and wherein the application can be repeated once every 2 to 8 weeks (see col. 4, lines 45-63 and col.7, claim 1).

Therefore, in view of teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the primary reference by incorporating the process for dyeing hair that involves successive applications to the hair as taught by Lapidus with reasonable expectation of success because Lapidus clearly teaches that dyeing hair with successive applications of dyeing composition in a short time period provided a deeper shades (see col. 2, lines 65-68 and col. 3, lines 1-4), and, thus, a person of ordinary skill in the art would be motivated to apply the dyeing composition with a successive applications to

obtain a deeper shades of color and would expect such a process to have similar properties and similar results to those claimed, absent unexpected results.

With respect to claim 7, it would have been obvious to one having ordinary skill in the art at the time the invention was made to contact the hair with the dyeing composition for a period of the claimed time because Lapidus teaches the application for a time period up to 5 minutes, which is a very short time period by conventional dyeing standard as taught by the reference (see col. 4, lines 47-49) and wherein the time period range is overlapping with the claimed range, and, thus, a person of the ordinary skill in the art would expect such a method to have similar properties and similar results to those claimed, absent unexpected results.

With respect to claim 8, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply to the hair the dyeing composition in a number of treatments with the claimed time interval because Lapidus teaches that the desired interval, determined by the user (see col. 4, lines 51-52), and thus, a person of the ordinary skill in the art would be motivated to determine the time interval between each two consecutive treatments includes those claimed, and would expect such a method to have similar properties and similar results to those claimed, absent unexpected results.

With respect to claims 9-22, it would have been obvious to one having ordinary skill in the art at the time the invention was made to calculate physical properties similar to those claimed, because the combined references teaches a hair dyeing compositions comprising similar dyeing ingredients with similar concentrations wherein the compositions applied with similar process of successive application, and, thus, a person of ordinary skill in the art would expect

such a process to have similar properties and similar results to those claimed, absent unexpected results.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Casperson et al. (US 5,376,146) in view of Lapidus et al. (US 4,104,021) and further in view of Duffer et al. (US 2003/0028979 A1).

The disclosures of Casperson (US' 146) and Lapidus (US' 021) are summarized above. The references fail to teach a method for dyeing hair comprising applying to the hair a dyeing composition comprising a volatile silicone as claimed.

However, the primary reference clearly teaches and suggests the use of the hair conditioners in the dyeing composition (see col. 8, lines 61-64).

Duffer (US' 979 A1) in another analogous art teaches a method for dyeing hair comprising applying to the hair a dyeing composition comprising volatile silicone (see page 5, paragraph 0077).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the composition of the primary reference by incorporating the volatile silicone as the conditioner agent as taught by Duffer for the reasonable expectation of success because the primary reference clearly teaches that conditioner agents are used in the hair dyeing composition, and, thus, a person of ordinary skill would expect such a process to have similar properties and similar results to those claimed , absent unexpected results.

6 Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Casperson et al (US 5,376,146) in view of Lapidus et al. (US 4,104,021) and further in view of Boult, Wade (EP 1 289 712).

The disclosures of Casperson (US' 146) and Lapidus (US' 021) are summarized above. The references fail to teach a dispenser for dispensing simultaneously part ai and aii in a method for dyeing hair as claimed in claim 29.

However, the primary reference of Casperson teaches a dyeing composition provided in a kit or package form ready for mixing by the user, either professional or personal, to initiate the dyeing process (see col. 10, lines 67-68 and col. 11, lines 1-2).

Boult (EP' 712) in analogous art of hair dyeing formulation, teaches a package adapted for the dispensing of a hair dye composition which package comprises a container with means to maintain two compositions A and B, therein isolated from each other. The composition (A) comprises oxidation bases and an alkaline substance adapted to produce a pH in the range of 8.5 to 10.0, oleic acid and ethoxylated (25) lanolin alcohol as conditioner agents and the composition (B) comprises oxidizing agent of hydrogen peroxide and cetyl alcohol as a conditioner agent, and valve means communicating with each of the compositions whereby the application of pressure to the compositions and actuation of the valve means results in the mixing of portions of each of the compositions and dispersing of the resulting mixture from the package as a hair dye composition (see page 5, Example 1 and page 7, claims 1 and 2). Further, the reference teaches a dispenser comprising valve means to communicate individually with the two compositions, the valve means being constructed such that actuation causes flow of composition A and composition B in the relative proportions of 1:1 (see page 5, Example 1).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to use such a dispenser in a process for dyeing hair with a reasonable expectation of success because the primary reference of Casperson teaches a hair dyeing composition provided in kit or package form ready for mixing by the user, either professional or personal, to initiate the dyeing process (see col. 10, lines 67-68 and col. 11, lines 1-2), and, thus, a person of the ordinary skill in the art would be motivated to use the disperser for dyeing hair with a reasonable expectation of success to obtain a homogenous and well mixed dyeing composition, absent unexpected results.

Claim Rejections - 35 USC § 102

7 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 32 is rejected under 35 U.S.C. 102(b) as being anticipated by Nillson, Agne (EP 0 146 350).

Nillson (EP' 350) teaches an aqueous composition for use in the coloring of hair which comprises an oxidizer component and a separate basic component. The basic component comprises in admixture an oxidation hair dye intermediate and ammonia as an alkalizing agent and the oxidizer component comprises 2 to 10% of hydrogen peroxide as an oxidizing agent and from 0.05 to 5% of quaternary ammonium compound as a conditioning agent (see pages 32-33, claims 1-5 and pages 10-31, Examples 1-21). Nillson teaches all the limitations of the instant claim. Hence, Nillson anticipates the claim.

Claim Rejections - 35 USC § 102

8 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 32-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Duffer et al. (US 2003/0028979).

Duffer (US' 979 A1) teaches a hair dyeing composition comprising a dye mixture and a developer mixture (see page 1, paragraph 0025). The dye mixture comprises dye intermediates in an emulsion form, alkalizing agent such as ammonium hydroxide and 0.4% of Oleyl alcohol as a conditioner agent which falls within the claimed range. The developer mixture comprises hydrogen peroxide as an oxidizing agent, volatile silicone of cyclomethicone in the amount of 4% which falls within the upper limit of the claimed range as claimed in claim 33 and anionic surfactant of ammonium lauryl sulfate as claimed in claim 34 (see page 5, paragraphs 0077, page 6, paragraph 0087 and page 10, Examples 1 and 2). Duffer teaches all the limitations of the instant claims. Hence, Duffer anticipates the claims.

Conclusion

The remaining references listed on from 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (703) 305-0217. The examiner can normally be reached on M - F (7:30-5:00) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Eisa Elhilo
Patent Examiner
Art Unit 1751

August 7, 2003